

Appln. No. 09/816,669  
Amd. dated December 3, 2003  
Reply to Office Action of October 7, 2003

REMARKS

The Office Action has been carefully reviewed. Claims 14, 15, 19, 20, 27, 28, 31, and 32 now presently appear in this application.

The examiner states that the original claims in the present application are drawn to 27 separate inventions (Groups I-XXVII). Applicants elect Group II, drawn to SEQ ID NO:4 and presently comprising claims 14, 15, 19 and 20, with traverse.

The requirement for restriction insofar as Groups II, XIV and XXII are concerned is traversed.

The examiner states that the antibodies of Group XIV-XVII are a class of proteins with distinct modes of operation as compared to the proteins of Groups II-V.

The restriction requirement is respectfully traversed insofar as the antibody of claim 27 is considered to be an independent and distinct invention from the protein of claim 14. Claim 27, as amended, reads:

27. A molecule which comprises the antigen-binding portion of an antibody specific for the protein of claim 14.

Applicants hereby concede that, if the polypeptide of claim 14 were available to the prior art (which includes knowledge of its biological activity as set forth in the claim), it would be *prima facie* obvious, within the meaning of 35 U.S.C. §103, for one of ordinary skill in the art to make an antibody which is specific

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to such protein. Techniques of raising antibodies, including monoclonal antibodies, are well known and the Patent and Trademark Office routinely rejects claims to monoclonal antibodies as being obvious if the protein against which it is specific is known to the prior art.

It should clearly be understood that the present admission is a one-way admission only. Applicants do not concede that if an antibody is known which happens to bind to a protein of claim 14, this would necessarily make the protein of claim 14 obvious or unpatentable. Furthermore, applicants do not concede that all monoclonal antibodies specific for a protein of claim 14 are necessarily obvious. Specific monoclonal antibodies may exist having unexpected properties which would not be obvious from prior art knowledge of the protein to which it is specific. However, in the present case, claim 27 is a broad claim to any antibody specific to a protein of claim 14 and the present concession is simply that there are antibodies within the scope of claim 27 which would not be patentable and would be *prima facie* obvious in the sense of 35 U.S.C. §103 if the protein of claim 14, including its biological properties, were known to the prior art. Knowing the biological activity of such protein, one of ordinary skill in the art would have been motivated to make an antibody for the purpose of immunoaffinity purification or for

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the purpose of blocking its activity. The techniques for doing so are well known.

In light of the present admission and the provisional election of the protein claims of Group II, a restriction requirement cannot be maintained. If the elected protein claims proceed to issue, any patent issuing on the antibody would have to be subject to an obviousness-type double patenting rejection in view of the above admission. See MPEP §804.II.B.1. relating to double-patenting rejections, which states:

In determining whether a non-statutory basis exists for a double-patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then "obvious-type" non-statutory double-patenting rejection may be appropriate.

However, such a double patenting rejection cannot be made in light of 35 U.S.C. §121. Reference is made to Section 803.01 of the MPEP, where it states:

Notwithstanding the fact that this section of the statute [35 U.S.C. 121] apparently protects the applicants against the dangers that previously might have resulted from compliance with an improper requirement for restriction, IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION. [Emphasis original]

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See also 37 C.F.R. §1.601(n) defining the concept of patentably distinct inventions from the interference perspective. This rule states:

Invention "A" is the **same patentable invention** as an invention "B" when invention "A" is the same as (35 USC 102) or is obvious (35 USC 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

Here, assuming the protein of claim 14 (invention "B") is prior art to the antibody of claim 27 (invention "A"), the antibody is *prima facie* obvious in light of applicants' admission. Thus, both claims are drawn to the same patentable invention. If they are drawn to the same patentable invention for interference purposes, they should be considered the same patentable invention for all purposes, despite any distinction in the material *per se*. As indicated above, no restriction requirement can be made which would result in the issuance of two patents for the same invention.

MPEP §803 refers to the case of *In re Lee*, 199 USPQ 108 (Comm'r for Pat 1978) as holding that restriction should not be required if there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. §103. However, such a two-way admission is not necessary as even the one-way admission presently being made is sufficient to result in two patents directed to the same invention. If an antibody claim in one patent would be obvious from a protein

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claim in another patent, then the two claims are not patentably distinct and the imprimatur of MPEP §803.01 quoted hereinabove must be invoked.

It should be noted that this identical issue has already been made the subject of a petition to the Commissioner by the undersigned with respect to another case and Deputy Director, Mary C. Lee, in a decision published as *In re Gold*, 42 USPQ2d 1095 (Comm'r Pats 1996) confirmed that, in such a circumstance, restriction requirement is not applicable. A copy of that decision is attached hereto. Note particularly where it states at 1096:

At this point it is noted that the fact that there is an admission that the antibody is obvious in view of the peptide but not an admission that the peptide is obvious over the antibody would not change this decision because the Office policy that "no restriction requirements be made which might result in the issuance of two patents for the same invention" would still control.

If claim 27 cannot be restricted from claim 14, then claims 27-28 must be examined with the elected claims 14, 15, 19 and 20, as the examiner has already taken the position that claim 28 is not patentably distinct from claim 27.

With regard to Group XXII, the claims are drawn to the use of the Group II protein of SEQ ID NO:4. Rejoinder is requested in accordance with MPEP 821.04. MPEP 821.04 states:

However, if applicant elects claims directed to the product, and a product claim is

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subsequently found allowable, withdrawn  
process claims which depend from or otherwise  
include all the limitations of the allowable  
product claim will be rejoined.

As all of the claims to the non-elected Groups other  
than Groups XIV and XXII have been deleted and as Group XIV must  
be examined with Group II for the reasons discussed above, all of  
claims 14, 15, 19, 20, 27, and 28 presently appearing in this  
case should be examined in the present application. Withdrawal  
of the restriction requirement to the extent requested herein and  
examination and allowance of all the claims now present in the  
case including claims 31 and 32, which would be rejoined by  
rejoinder practice, are therefore earnestly solicited.

Respectfully submitted,

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Toys, Inc., 1481] (N.D. ois' tortious e preempted ts. With re- ous interfe- nfringement ized publica- ASA Corp., rper & Row s., 723 F.2d Cir. 1983)). e attempt to m. from the it statute by f intentional endants. But examination, re, it cannot competition

counts are predicated on exactly the same conduct as that underlying the copyright counts — viz., copying unique designs." 869 F.Supp. at 1361.

The tortious interference claim, like the UDTPA claims, is preempted because it is in essence a claim of copyright infringement. The fact that the Illinois claims contain an element of deception or misrepresentation does not effect this court's preemption analysis. All of the state-law claims are preempted by the broad reach of 17 U.S.C. §301.

IT IS THEREFORE ORDERED THAT the defendants' motions to dismiss counts III, IV and V (docket # 68 & 72 & 77) are granted.

**U.S. Patent and Trademark Office  
Commissioner of Patents and Trademarks**

In re Gold

PLM Paper No. 18

Decided December 31, 1996

(Unpublished)

**PATENTS**

**1. Practice and procedure in Patent and Trademark Office — Prosecution — Rules and rules practice (§110.0905)**

**Patentability/Validity — Anticipation — Double patenting (§115.0708)**

Patent examiner is directed to withdraw requirement for restriction between claims in protein group and claims in antibody group in patent application, since Manual of Patent Examining Procedure's Section 803 states that restriction should not be required if there is express admission that claimed inventions are obvious over each other within meaning of 35 USC 103, since "patentable distinctness" issue between peptide and antibody groups in application is close, and since admission in present case, although it does not specifically mention 35 USC 103, states that antibody is obvious over peptide; absence of corresponding admission that peptide is obvious over antibody does not warrant contrary decision, in view of Patent and Trademark Office policy that "no restriction requirements be made which might result in the issuance of two patents for the same invention."

Patent application of Leslie I. Gold, et al. On applicants' petition requesting that restriction requirement be withdrawn. Petition granted.

[Editor's Note: The U.S. Patent and Trademark Office has not designated this decision as prepared for publication. It is not binding precedent of the Commissioner of Patents and Trademarks.]

Roger L. Browdy, of Browdy & Neimark, Washington, D.C., for petitioner.

Lee, deputy director, patent examining group 1800.

This is a decision on the petition under 37 CFR 1.181 and 37 CFR 1.144, filed November 4, 1996, to withdraw the restriction requirement with respect to Groups I/II and VI. Note, petitions from restriction requirements are properly considered under 37 CFR 1.144. Therefore, the petition is being treated as a petition under 37 CFR 1.144.

On April 7, 1995, an Office action was mailed that required restriction between claims 1-9 and 13 (Group I), claims 10-12 (Group II), claims 14-15 (Group III), claim 16 (Group IV), claim 17 (Group V), claim 18 (Group VI), and claims 19 and 20 (Group VII). With an election of Group II, applicant was further required to elect one of two patentably distinct species of the invention. In response to the Office action, applicants timely filed a response on August 7, 1995 in which applicants canceled claims 14-17 drawn to Groups III, IV and V, elected Group I, claims 1-9 and 13, and traversed the restriction requirement insofar as the claims of Groups II, VI and VII were deemed to be independent and distinct from the elected invention. On November 28, 1995, an Office action was mailed which withdrew the requirement for restriction between Groups I/II and Groups VI and VII. In applicants' response filed May 28, 1996, a request for reconsideration of the requirement for restriction with respect to Groups VI and VII was made. On September 4, 1996, a final Office action was mailed which reaffirmed the requirement for restriction. The present petition was filed on November 4, 1996 requesting that the restriction requirement between Groups I and VI be withdrawn at least to the extent of considering claim 5 to be a linking claim so that claim 18 will be considered at the time that claim 5 is allowable.

Petitioner asserts that applicants have conceded that if the protein of claim 5 (from Group I/II) is anticipated or obvious then the antibody of claim 18 (Group VI) would

also be obvious as it would be obvious to make an antibody to any known peptide. Thus, petitioner contends that if a patent issues containing a claim drawn to the protein of claim 5, and a divisional application is filed resulting in the issuance of a claim of the scope of claim 18, two patents will have issued drawn to inventions which are not patentably distinct. Absent 35 U.S.C. 121, a double-patenting rejection would have to be made on the antibody claim because it is admittedly obvious from the protein. Thus, petitioner concludes that the restriction requirement between Groups I/II and VI should be withdrawn.

[1] As argued by petitioner, MPEP § 803 is appropriate here where it states:

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required, *In re Lee*, 199 USPQ 108 (Deputy Asst. Comm'r. For Pats. 1978).

The decision in *In re Lee* was based not only on the presence of an admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103 but also on the fact that the issue of "patentable distinctness" between the two groups was close and the Office policy:

[T]hat it is important from the standpoint of public interest that no restriction requirements be made which might result in the issuance of two patents for the same invention. The nullification of double patenting as a ground of rejection provided for in the third sentence of 35 U.S.C. 121 imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essen-

tially the same invention and which if acquiesced in, might result in more than one patent for essentially the same invention with attendant prolongation of patent monopoly.

Here, the Office policy is the same as when *In re Lee* was decided and like in *In re Lee*, the "patentable distinctness" issue between the peptide of Group I/II and the antibody of Group VI is close. Lastly, while the admission in this case does not explicitly state that the antibody is obvious over the peptide "within the meaning of 35 U.S.C. 103", the admission certainly implies this and that is how the admission is hereby interpreted. Therefore, like *In re Lee*, it is concluded that the public interest is better served by withdrawing the restriction requirement and permitting both inventions to be prosecuted in the same application. At this point it is noted that the fact that there is an admission that the antibody is obvious in view of the peptide but not an admission that the peptide is obvious over the antibody would not change this decision because the Office policy that "no restriction requirements be made which might result in the issuance of two patents for the same invention" would still control.

In conclusion, the petition is granted and the examiner is directed to withdraw the requirement for restriction between Groups I/II and VI. Group VII remains restricted from Groups I/II/VI. The application is being returned to the examiner for appropriate action in a timely manner.

PETITION GRANTED.

## TRADE PRACTICE

### 1. Unfair Act

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### 2. Unfair (§390)

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### 3. Unfair Act Se

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## JUDICIAL PROCEDURE

### 4. Procedure mony (§

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